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09/484,861	01/18/2000	Jeffrey Kohl Wilkins	SFT-101	1211

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/484,861

Applicant(s)

WILKINS ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

-- The MAILING DATE of this c mmunication appears on the c ver she t with the c rresp nd nce address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-33 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-33 and 35-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Due to communications filed 8/1/03, the following is a non-final office action. Claims 1, 3-33 and 35-46 are pending in this application and have been examined on the merits. The previous rejection has been withdrawn, and the following rejection is based on the Declaration filed 1/16/03 and the response filed 8/1/03.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3-9, 11, 18, 22, 23-26, 29, 32, 33, 35-41, 43, 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (US 6,067,525).

As per claims 1, 33, Johnson et al discloses:

Determining at least one source available to be accessed and searched in said distributed computer system (Col. 33, lines 35-38, where determining occurs during the programming state, and the source is represented by the sales events);

Searching and accessing said source to identify purchase indicators representing potential future purchases by prospects, said purchase indicators being contained within files in said source (Col. 33, lines 35-41, where searching is represented by monitoring and the purchase indicators are represented by sales events such as the purchase of a product, a repeat sale to a customer, a large number of leads being qualified to potential customer, etc);

Extracting prospect identifiers from said purchase indicators, wherein said prospect identifiers identify said prospects (Col. 33, lines 41-44, where the prospect identifiers are represented by the identification of events).

Generating said intender lead from said prospects without human intervention (Col. 33, line 60-Col. 34, line 7, where the prediction of the most successful course of action represents the intender lead, w/ Col. 4, lines 21-43, where the process being fully automated represents the "without human intervention" limitation)

Program of instructions/ Program code means...(Col. 30, lines 23-28, represented by object oriented programming);

As per claims 3, 4, 24, 35, 36, Johnson et al discloses:

Further comprising the step of transferring said intender lead to an interested party.../ Wherein the transferring step occurs before said potential future purchases/

program code means for transferring (Col. 11, lines 54-57, represented by transferring the lead information to the salesperson);

As per claims 5, 37, Johnson et al discloses:

Further comprising the step of initiating a direct marketing contact/program code means for initiating a direct marketing contact (Col. 17, lines 54-58, represented by the customer dealing directly with the salesperson).

As per claims 6, 8, 25, 38, 40, Johnson et al discloses:

Wherein said prospect identifiers are selected from the group consisting of telephone numbers, email addresses.../wherein said additional information comprises contact information...(Col. 13, lines 7-16, represented by the addresses and phone numbers in the customer-specific information).

As per claims 7, 39, Johnson et al discloses:

Further comprising the step of obtaining additional information associated with said prospects from a profile database/program code means for obtaining additional information associated with said prospects from a profile database (Col. 6, lines 16-25, represented by retrieving data using one or more databases).

As per claims 9, 26, 41, Johnson et al discloses:

Wherein said additional information comprises data enhancement (Col. 16, lines 21-39, represented by editing).

As per claims 11, 28, 29, 43, Johnson et al discloses:

Wherein said files are selected from the group consisting of classified advertising.../wherein said auxiliary data includes a classification of a product...(Col. 27, lines 3-8, Fig. 15A, represented by Product Information).

As per claims 22, 32, 46, Johnson et al discloses:

Wherein said distributed computer system is in the Internet...(Col. 11, lines 3-10).

As per claim 23, Johnson et al discloses:

Identifying purchase indicators representing potential future purchases by prospects, said purchase indicators being contained within files in said distributed computer system, said prospects including said intender lead (Col. 33, lines 35-46, where the identification of the purchase indicators are represented by sales events such as the purchase of a product, a repeat sale to a customer, a large number of leads being qualified to potential customer, etc and where the events being stored in the event manager database represents the purchase indicators being contained within files);

Extracting prospect identifiers from said purchase indicators (Col. 33, lines 41-44, where the prospect identifiers are represented by the identification of events).

Obtaining contact information for said prospects from a profile database wherein said contact information is associated with said prospect identifiers in said profile database (Col. 35, lines 3-13, where tracking customer profile information represents obtaining contact information from a profile database and the "associated" step is represented by the "correlate" step in Johnson et al).

Applying a predictive model to said prospect identifiers and said contact information to select said intender lead from said prospects (Col. 33, line 60-Col. 34, line 7, where the prediction of the most successful course of action represents the intender lead, w/ Col. 4, lines 21-43, where the process being fully automated represents the “without human intervention” limitation}).

Transferring contact information for said intender lead to an interested party (Col. 35, lines 10-13, where the contact information for the intender lead is represented by the information in the customer profile, and the transferring step is represented through the “presentation” step in Johnson. Here, the information from the customer profile is set as default for the system that produces the presentation, and the customer profile information will therefore be presented, and the interested party is represented by one who logs onto the system);

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent 6,067,525), and further in view of Goldhaber et al (US Patent 5,855,008).

As per claim 18, Johnson fails to disclose the following, however Goldhaber et al discloses:

Wherein said auction boards comprise bids for auctioned items...(Col. 4, lines 52-67, [advertisers making fixed offers]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for auction boards to comprise bids for auctioned items with the motivation of informing the customer about different bidding options, thereby producing substantial purchase indicator information.

6. Claims 10, 27, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent 6,067,525), and further in view of Walker et al (US 3,639,686).

As per claims 10, 27 and 42, Johnson et al fails to teach the following, however Walker et al discloses:

Further comprising the step of extracting auxiliary data/program code means for extracting auxiliary data (Col. 3, lines 22-36, [where auxiliary data comes from the auxiliary signal] ).

It would have been obvious to one of ordinary skill in the art to extract auxiliary data from the purchase indicators with the motivation of determining outside influences that may have an effect on lead purchasers.

7. Claims 12-14, 30, 31, 44, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent 6,236,977).



As per claims 12-14, 30, 31, 44 and 45, Johnson et al doesn't explicitly disclose the following:

wherein said purchase indicators comprise classified automobile sales...classified home sales...classified boat and RV sales...

However, Johnson et al does disclose an automated sales system that incorporates electronic advertising in order to generate leads (See Col. 4, lines 21-27). It would have been obvious to one of ordinary skill in the art for the purchase indicators to comprise classified automobile sales, classified home sales and classified boat and RV sales because it is traditional to include classified ads in an electronic advertising environment, in order to give the customer greater flexibility in his selection process.

As per claims 15, 16, 19-21, Johnson et al fails to disclose the following:

Wherein said purchase indicators comprise resumes...engagement/wedding announcements, birth announcements...obituaries...

Official notice is taken that it is old and well-known in the art for a purchase indicator to comprise resumes, engagement/wedding announcements, birth announcements and obituaries. It would have been obvious to one of ordinary skill in the art for the purchase indicator to comprise resumes, engagement/wedding announcements, birth announcements and obituaries with the motivation of demonstrating the ability to present the purchaser with items of everyday interest, thereby encouraging prospect leads to come forward and make purchases.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent 6,236,977), and further in view of Lazarus, et al (US Patent 6,236,977).

As per claim 17, Johnson et al fails to disclose the following:

Wherein said postings comprise requests for purchase recommendations...(Col. 5, lines 18-27).

It would have been obvious to one of ordinary skill in the art to post requests for purchase recommendations with the motivation of providing information about items being purchased thereby making it easier to determine potential leads.

### ***Response to Arguments***

9. Due to the declaration files 1/16/03, the Verba et al (US 6,236,977) and Cannon (US 6,286,005) references have been withdrawn as prior art.

10. Applicant's arguments filed 8/1/03 have been fully considered but they are not persuasive.

As per claims 1, 23, and 33, the applicant argues that Johnson fails to disclose applying a predictive model to select intender leads from prospects. However, in col. 33, line 60-Col. 34, line 7, Johnson describes a situation where the determination of customers in the particular customer's geographic region who participate in the type of incentive programs is made. This is done by sending a letter in order to make offers to a specific customer. In this case, the determination of customers in the geographic region represents the selection of intender leads. This determination is predicting "who they are" as stated by the applicant.

The applicant also argues the Johnson does not teach how to identify, mine, or utilize events readily available in a distributed computer system such as the Internet and

Art Unit: 3623

continues to argue that Johnson's invention is a sales funnel optimization of prospects that have proactively purchased a product or proactively expressed interest in doing so while the claimed invention operates with out the customers product purchases and generates qualified prospects that are ready to purchase in the near future. However, Johnson describes the incorporation of future sales into his invention in Col. 4, lines 12-16. Here, Johnson discloses that core process components relate to particular phases of a sales process such as the retention of a satisfied customer for future sales.

In addition, the applicant argues that Johnson discloses an expert system that uses explicit rules where the present invention uses a predictive model, which relies on automatically discovered statistical relationships between input/output variables. However, Johnson utilizes a forecasting module. This forecasting module is shown in col. 21, lines 30-39 and represents the predictive model since it is shown that the forecasting module provides functional and product information stored by products identified in the sort criteria. This product information is input into the system.

The applicant also argues that there is no teaching on how partial information is augmented and matched. However, the presales phase of Johnson in Col. 35, lines 3-12 is partial since information is gathered and activities are examined for a certain phase out of many phases of the sales process.

The applicant also argues that the claimed invention doesn't require direct interactions between the marketer and the prospect. However, Col. 4, lines 28-43 of Johnson discloses a situation where data is already available from a database. In this case, a direct interaction is not necessary.

As per claims 5 and 37, the applicant argues that Johnson does not disclose a system where customers do not have knowledge of being selected. However in col. 11, lines 3-18 of Johnson, the lead-generation component is disclosed, which is directed to pre-sales activities and is installed at various sites such as from trade shows, kiosks, Internet Web sites, or electronic advertising. When customers utilize these resources, the lead-generation component gathers lead information from the customer's interaction with the resources.

As per claims 6, 8, 25, 38 and 40, the applicant argues that Johnson doesn't teach how prospects and their contact information is automatically identified. However, in Col. 13, lines 7-16, Johnson discloses the customer module, which is used by the salesperson to facilitate gathering of customer-specific information such as addresses and phone numbers. In Johnson, it is disclosed that the processes of his invention can be carried out automatically (See Col. 4, lines 41-43).

As per claims 7 and 39, the applicant argues that Johnson only deals with histories of interaction. However, Johnson discloses pre-sales lead generation in the abstract, lines 3-5. in addition, in Col. 4, lines 54-57, it is shown that process components are used during the phase of the sales process, which begins at the time a qualified lead is identified. The time a qualified lead is identified is not historical.

As per claims 9, 26 and 41, the applicant argues that Johnson does not disclose "data enhancement". However, "editing" is a form of data enhancement since data used in the process is changed or enhanced to another format. In addition, Col. 35, lines 1-12 of Johnson discloses leveraging information from customer profile information in

order to glean what types of presentations are effective with a particular customer profile. After this information is gleaned, this information is set as a default for the system. Specific types of information may also be tagged for inclusion in a presentation on the basis of a customer's profile. Setting this information to default and tagging both represent data enhancement.

As per claims 11, 28, 29 and 43, the applicant argues that Johnson does not specify the source of the data as classified advertising. However, in Col. 4, lines 21-27 of Johnson, electronic advertising is disclosed, and classified advertising is a form of electronic advertising.

As per claims 22, 32 and 46, the applicant argues that Johnson does not disclose automation. However, in Col. 4, lines 41-43, Johnson discloses that the process of the invention can be fully automated.

As per claims 12-14, 30, 31, 44 and 45, the applicant argues that Johnson fails to disclose a system where there is indirect contact between the prospect and the marketer, and that the marketer places the ads to initiate an explicit dialogue with the prospect. However, as shown in Col. 4, lines 29-33 of Johnson, data developed and used during the lead generation phase of the sales process is stored in a retrieved from a database in the data component. Johnson also discloses that such a process can be fully automated. Therefore, the marketer does not need to have direct contact with the prospect.

As per claims 15, 16, and 19-21, the applicant argues the official notice that states that it is old and well known in the art for a purchase indicator to comprise

Art Unit: 3623

resumes, engagement/wedding announcements, birth announcements and obituaries. However, in the applicant's admissions on page 3, paragraph 2 of the specification, the applicant states that "Many web sites have banner ads along the top of the page that are provided directly by an advertising company...". In the case of logging on to a marriage web site, as part of the advertising campaign, these sites do give engagement/wedding announcement options to the customers in order to present this customer with items of common interest, thereby encouraging the customer to come forward and purchase wedding related items or announcement slots. This is proven on The Wedding Help Line page (Included in the Notice of References Cited). On this page, one can see that Wedding Announcements are included on a banner of the web site to allow users to view online engagement and wedding announcements. When tracking these types of banner clicks, one would be able to determine indicators for customers who would purchase an item in a wedding/birth category.

As per claim 17, the applicant argues that Johnson lacks any teachings to enable the integration of public postings into the expert system so to extract information contained therein to identify prospects. However, the combination of Johnson and Lazarus discloses this limitation. In Col. 5, lines 18-27 of Lazarus, it is disclosed that a user's profile vector is configured to track observed behavior by using the content vector representation of the associated actions including responding to ads which are public postings.

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R-B.  
October 14, 2003



**TARIQ R. HAFIZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**